

Nobuhiro ITOH, S.N. 10/685,098
Page 11

Dkt. 2271/71239

REMARKS

The application has been reviewed in light of the Office Action dated May 21, 2008. Claims 1-33 are pending. By this Amendment, independent claims 1, 11, 14 and 24 have been amended to clarify the claimed subject matter. Upon entry of this Amendment, claims 1-33 remain pending, with claims 1, 11, 14 and 24 being in independent form.

Claims 1-36 were rejected under 35 U.S.C. § 103(a) as purportedly unpatentable over U.S. Patent No. 5,809,116 to Cairo in view of U.S. Patent No. 6,025,931 to Bloomfield.

Applicant respectfully submits that independent claims 1, 11, 14 and 24 are patentable over the cited art for at least the reason that the cited art does not disclose or suggest (i) *storing destination names of specific destinations in a storage section*, (ii) outputting a communication result notification indicative of a result of the facsimile transmission to the receiving end *only when the corresponding destination name is found in the storage section*, (iii) wherein when the destination name corresponding to the receiving end to which the facsimile transmission is made is *found amongst the destination names stored in the storage section*, a communication result notification is output.

Cairo does not disclose or suggest any of the aspects (i), (ii) and (iii).

Cairo, as understood by applicant, proposes an approach for providing facsimile certification, upon request for such certification service, that involves tuning into, through a local switch, a transmission by an originating telephonic unit via a public switch telephone network to a destination telephonic unit.

Cairo, column 5, lines 45-66 (reproduced below), was cited in the Office Action:

... When the controller 28 detects an end-of-page message from the originating fax 10 and a page acknowledge message from the destination fax 16, the controller 28 instructs the data switch to interrupt the transfer of data from the buffer

Nobuhiro ITOH, S.N. 10/685,098
Page 12

Dkt. 2271/71239

to the certification fax and, instead, pass *indicia of delivery from an output of the controller 26 while the buffer accumulates any new data from succeeding fax pages. Once the data switch transfers the indicia of delivery from the controller 28 to the certification fax followed by a locally generated end-of-page, which indicia is printed on the bottom quarter of the fax page*, the controller 28 again instructs the data switch to pass data from the buffer.

In another embodiment of the invention, the telephonic transmission is not printed immediately with indicia of delivery associated with each page but, rather, the entire transmission is stored as a common file with indicia associated with the entire file stored in conjunction with the file as a composite file. As with above embodiments, the composite file is stored in a secure facility with *a single summary page printed after creation of the composite file and sent to the operator of the originating telephonic unit for record keeping purposes*. Should a need arise for proof of delivery, the entire composite file is printed upon demand.

Thus, Cairo proposes outputting, in every instance of successful transmission (as manifested by an end-of-page message from the originating fax 10 and a page acknowledge message from the destination fax 16), an indicia of delivery, either immediately or upon creation of a composite file.

Cairo says nothing whatsoever regarding making output contingent upon the destination name (corresponding to the receiving end to which the facsimile transmission is made) being *found amongst destination names stored in a storage section*.

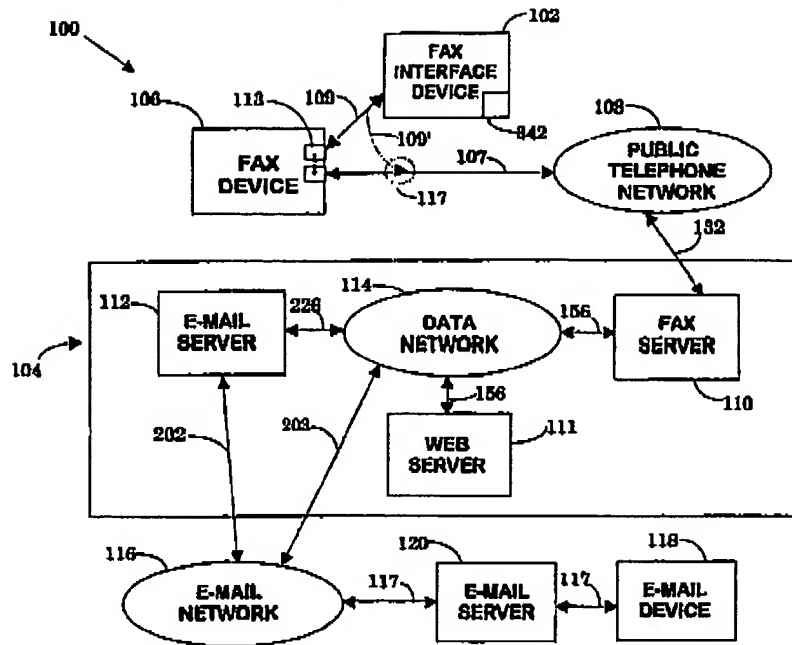
Bloomfield likewise does not disclose or suggest any of the aspects (i), (ii) and (iii).

Bloomfield, as understood by applicant, proposes an approach utilizing a fax server (110) and an e-mail server (112) whereby a hardcopy document is sent via a fax device (106) and fax interface device (102) to a recipient via electronic mail through the Internet (114), and is delivered in such a manner that it can be retrieved by the recipient at an E-mail device (118), in the ordinary course of retrieving the E-mail, and displayed on the screen of the E-mail device 118. Such a system is shown in Bloomfield, Fig. 1, which is reproduced below.

Nobuhiro ITOH, S.N. 10/685,098
Page 13

Dkt. 2271/71239

FIG. 1



Bloomfield, column 6, lines 47-67 (reproduced below), was cited in the Office Action:

The Fax-Server 110 monitors its fax/data communication channels for a call from a fax interface device 102. Upon receiving such a call on its fax/data communication channel, the Fax-Server 110 services the call by, among other tasks, verifying (against a *stored list of valid identification codes of fax interface devices* 102) that the call is to be processed; receiving from the fax interface device 102, an E-mail address associated with a desired recipient of a document; optionally receiving information identifying the sender; receiving fax image data representative of the document to be communicated to the desired recipient; optionally preparing and *forwarding a confirmation (i. e., a fax document comprising a single page having text which indicates that the recipient's E-mail address and the fax image data representing the document were received by the Fax-Server 110) to the fax device 106*; and, preparing and forwarding an E-mail message 270 (see FIG. 4), having an E-mail message portion 272 and an attached image data file 274 including data representative of the document, to the E-mail-Server 112.

Thus, in the system proposed by Bloomfield, when the fax server 110 receives a call from the sending end (that is, fax device 106 and fax interface device 102), the fax server 110 checks whether the identification of the *sending end* is on a list of valid identification codes (that is, of

Nobuhiro ITOH, S.N. 10/685,098
Page 14

Dkt. 2271/71239

senders from whom communication would be allowed to proceed and is confirmed in the system of Bloomfield).

However, it is noted that the receiving end in the system of Bloomfield is the e-mail device 118 and Bloomfield does not disclose or suggest checking whether the receiving end is on the valid list.

The valid identification codes maintained by the system of Bloomfield correspond to senders from whom communication would be allowed to proceed and the fax server 110 checks whether the sender is on the list.

Bloomfield does **NOT** express a concern that the receiving end should be on a list of authorized destinations.

Cairo and Bloomfield simply do not disclose or suggest (i) *storing destination names of specific destinations in a storage section*, (ii) outputting a communication result notification indicative of a result of the facsimile transmission to the receiving end *only when the corresponding destination name is found in the storage section*, (iii) wherein when the destination name corresponding to the receiving end to which the facsimile transmission is made is *found amongst the destination names stored in the storage section*, a communication result notification is output.

Applicant submits that the cited art, even when considered along with common sense and common knowledge to one skilled in the art, does **NOT** render unpatentable the above-mentioned aspects of the present application.

Accordingly, Applicant respectfully submits that independent claims 1, 11, 14 and 24, and the claims depending therefrom, are allowable over the cited art.

In view of the remarks hereinabove, Applicant submits that the application is now in

Nobuhiro ITOH, S.N. 10/685,098
Page 15


Dkt. 2271/71239

condition for allowance. Accordingly, Applicant earnestly solicits the allowance of the application.

If a petition for an extension of time is required to make this response timely, this paper should be considered to be such a petition. The Patent Office is hereby authorized to charge any fees that are required in connection with this amendment and to credit any overpayment to our Deposit Account No. 03-3125.

If a telephone interview could advance the prosecution of this application, the Examiner is respectfully requested to call the undersigned attorney.

Respectfully submitted,



Paul Teng, Reg. No. 40,837
Attorney for Applicant
Cooper & Dunham LLP
Tel.: (212) 278-0400